

## REMARKS

The only amendment to the claims presented by this Amendment is the cancellation of Claim 1.

The Summary of the Invention portion of the specification is amended to be consistent with original independent Claim 2.

### *Claim Rejections*

The rejection of Claims 2, 3, 32, 35, 39-48, 67, 69 and 77-79 under 35 USC 103(a) as being unpatentable over *Uchio* in view of *Kossovsky* is respectfully traversed for the following reasons:

#### Claims 2 and 69

*Uchio* does not teach systematically establishing contractual obligations by the contributors of ideas to a database to transfer property rights to inventions derived at least in part from the ideas accumulated in the database, as recited in independent Claims 2 and 69. The portions of *Uchio* cited by the Examiner do not describe or suggest establishing such contractual obligations. If the Examiner believes that any portion of *Uchio* discloses or suggests establishing any such contractual obligations, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests establishing any such contractual obligations.

Neither *Uchio* nor *Kossovsky* suggest any motivation for adding the features of *Kossovsky*'s online commercial network system, which is designed to facilitate purchase and license exchange of IP assets, to *Uchio*'s system for managing documents relevant to patent applications. Neither reference suggests any motivation for adding the features of *Kossovsky*'s IP asset exchange system to *Uchio*'s document management system as an essential means to increase the efficiency and reliability of *Uchio*'s system in determining an accurate market value for the patented technology, as asserted by the Examiner.

It is not understood why a person of ordinary skill in the art would look to *Kossovsky's* teaching of an IP asset exchange system for the purpose of enhancing *Uchio's* document management system. *Uchio's* document management system is not concerned with determining an accurate market value for the patented technology, as asserted by the Examiner. The Examiner is respectfully requested to explain how the cited references suggest the motivation asserted by Examiner.

Even if the features of *Kossovsky's* online commercial network system were to be added to *Uchio's* system, the present invention would not be realized because, as pointed out above, *Uchio* does not teach or suggest systematically establishing the contractual obligations recited in independent Claims 2 and 69. Such motivation was first described in the present application at page 8, lines 1-17.

#### Claim 3

The portion of *Uchio* cited by the Examiner does not disclose or suggest the feature of using a computer to systematically establish the contractual obligations recited in independent Claim 2, as required by dependent Claim 3. If the Examiner believes that any portion of *Uchio* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests this feature.

#### Claim 32

The portion of *Uchio* cited by the Examiner does not disclose or suggest combining the feature of systematically entering into the accumulated invention ideas database all of the ideas that are submitted for entry into the database, as required by dependent Claim 32 with the feature of systematically establishing contractual obligations by the contributors of the ideas to transfer property rights to inventions derived at least in part from the ideas accumulated in the database, as recited in Claim 2. If the Examiner believes that any portion of *Uchio* discloses or suggests combining these features, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests combining these features.

#### Claim 35

The portion of *Kossovsky* cited by the Examiner does not disclose or suggest the feature of systematically entering the submitted ideas into the accumulated invention ideas database of independent Claim 2 without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entry of said contributions, as required by dependent Claim 35. If the Examiner believes that any portion of *Uchio* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Kossovsky* discloses or suggests this feature.

#### Claim 39

The portion of *Uchio* cited by the Examiner does not disclose or suggest the feature of requiring persons to enter into a membership as a prerequisite for viewing a portion of the accumulated invention ideas database of independent Claim 2, as required by dependent Claim 39. The disclosed “ID number” is not a membership ID number. If the Examiner believes that any portion of *Uchio* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests this feature.

#### Claim 40

The portion of *Uchio* cited by the Examiner does not disclose or suggest the feature of requiring contributors of ideas for prospective entry into the accumulated invention ideas database of independent Claim 2 to enter into a membership as a prerequisite for contributing ideas for entry into said database, as required by dependent Claim 40. The disclosed “ID number” is not a membership ID number. If the Examiner believes that any portion of *Uchio* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests this feature.

#### Claim 41

The portion of *Uchio* cited by the Examiner does not disclose or suggest combining the feature of facilitating preparation and/or filing of patent applications for at least some inventions derived at least in part from ideas accumulated in the database, as required by dependent Claim 41 with the feature of systematically establishing contractual obligations by the contributors of the ideas to transfer property rights to inventions derived at least in part from the ideas accumulated in the database, as recited in Claim 2. If the Examiner believes that any portion of *Uchio* discloses or suggests combining these features, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests combining these features.

#### Claim 42

The portion of *Kossovsky* cited by the Examiner does not disclose or suggest combining the feature of auctioning at least some right under the patent rights to at least some inventions derived at least in part from ideas accumulated in the database, as required by dependent Claim 42 with the feature of systematically establishing contractual obligations by the contributors of the ideas to transfer property rights to inventions derived at least in part from the ideas accumulated in the database, as recited in Claim 2. If the Examiner believes that any portion of *Kossovsky* discloses or suggests combining these features, the Examiner is respectfully requested to explain how any portion of *Kossovsky* discloses or suggests combining these features.

#### Claim 43

The portion of *Uchio* cited by the Examiner does not disclose or suggest the feature of recording the time of receipt of each idea contributed for entry into the accumulated invention ideas database of independent Claim 2, as required by dependent Claim 43. The disclosure of updating information in the database does not suggest recording the time of such an update. If the Examiner believes that any portion of *Uchio* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests this feature.

#### Claim 44

The portion of *Uchio* cited by the Examiner does not disclose or suggest the feature of recording a time of publication in the accumulated invention ideas database of independent Claim 2, as required by dependent Claim 44. The dates shown in FIG. 30 are not dates of publication in the idea accumulation database. If the Examiner believes that any portion of *Uchio* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests this feature.

#### Claim 45

The portion of *Kossovsky* cited by the Examiner does not disclose or suggest the feature of recording a time of first public viewing of an idea from the accumulated invention ideas database of independent Claim 2 of each such accumulated idea, as required by dependent Claim 45. The dates shown in FIG. 12 are not dates of first public viewing of an idea in the idea accumulation database. If the Examiner believes that any portion of *Uchio* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Uchio* discloses or suggests this feature.

#### Claim 46

As to Claim 46, it appears that the Examiner intended to cite paragraph 0112 of *Kossovsky*, (rather than of *Uchio*), since such paragraph of *Kossovsky* discloses a “contractual right to purchase a technology from its owner at a predetermined price before a set expiration date”. Notwithstanding such disclosure, *Kossovsky* does not disclose nor suggest the feature of providing contingent contractual rights to at least some inventions derived at least in part from the ideas accumulated in the accumulated invention ideas database of independent Claim 2, as required by dependent Claim 46. If the Examiner believes that any portion of *Kossovsky* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Kossovsky* discloses or suggests this feature.

#### Claim 47

The portion of *Kossovsky* cited by the Examiner does not disclose or suggest the feature of enabling ideas contributed to the accumulated invention ideas database of independent Claim 2 to be integrated within said database to thereby facilitate derivation of inventions from said integrated ideas, as required by dependent Claim 47. If the Examiner believes that any portion of *Kossovsky* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Kossovsky* discloses or suggests this feature.

#### Claim 48

The portion of *Kossovsky* cited by the Examiner does not disclose or suggest the feature of systematically establishing contractual obligations by contributors of ideas the accumulated invention ideas database of independent Claim 2 to permit immediate public disclosure of said ideas contributed by said, as required by dependent Claim 48. If the Examiner believes that any portion of *Kossovsky* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Kossovsky* discloses or suggests this feature.

#### Claims 67 and 77-79

*Uchio and Kossovsky* do not disclose or suggest the feature of systematically performing each of the steps recited in independent Claim 2 and dependent claims 40, 45, and 47. If the Examiner believes that any portion of *Uchio or Kossovsky* discloses or suggests this feature, the Examiner is respectfully requested to explain how any portion of *Uchio or Kossovsky* discloses or suggests this feature.

***Disclosure of Documents Filed in US Application Claiming Related Subject Matter***

Attached hereto, please find the following documents that were filed during the prosecution of applicants' co-pending Application No. 10/072,071, which is a continuation-in-part of the present application, and in which the pending claims are directed to subject matter that is closely related to the subject matter that is claimed herein:

- Preliminary Amendment and Petition to Make Special (dated October 17, 2002)
- Reply to Written Opinion Under Rule 66 in International Application No. PCT/US01/25317 (dated October 1, 2002)
- International Preliminary Examination Report in International Application No. PCT/US01/25317 (dated January 17, 2003)

The present application is based upon said International Application No. PCT/US01/25317, from which applicants entered the national stage under 35 USC 371 on October 25, 2001 prior to demanding International Preliminary Examination. International Application No. PCT/US01/25317 was filed August 10, 2001 and is supported by the disclosure of Provisional Application No. 60/227,687 filed August 24, 2000.

The Reply and the International Examination Report were included in an Information Disclosure Statement for Application No. 10/072.071 that was filed on March 4, 2003.

Copies of the various references discussed in said Petition and in said Reply were provided with previously filed Information Disclosure Statements for the present application. Some of such references were published after the effective priority date of at least some of the claims.

### ***Discussion of Additional Previously Disclosed Documents***

The following documents also are believed to be relevant to the claimed subject matter of the present application:

Powell	US Application Publication No. 2001/0032189 A1
Cronin	US Application Publication No. 2001/0034629 A1
Waters	US Application Publication No. 2002/0032659 A1
Idea Exchange	"Protecting Your Ideas"

Copies of such documents were provided with previously filed Information Disclosure Statements for the present application.

At least some of such documents were published after the effective priority date of at least some of the claims.

Powell discloses a computer network in which users are required to enter into various agreements, including confidentiality agreements and license agreements granting access to selected ideas in a database. See the Abstract, Figures 1a, 1b, 2 and 9a and paragraphs 5, 10, 11, 13, 14, 34, 36, 41, 42, 71-73, 76, 81, 99 and 118.

Cronin discloses a computer system for facilitating creation of inventions by a group of participants. See the Abstract and paragraphs 17 and 18.

Waters discloses a networked computer system for obtaining new ideas from independent sources and integrating the inputs of experts. See FIG. 1A and 1B, the Abstract and paragraphs 15 and 16.

Idea Exchange discloses a computerized idea exchange, which requires members to enter in a contract that includes a confidentiality agreement. See the Contractual Protection section.



***Conclusion***

Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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